

REMARKS

Claims 1-8 are pending in this application. By this Amendment, claims 1-7 are amended, and claim 8 is added. No new matter is added as support for new claim 8 may be found in the originally filed disclosure, e.g., at page 1, line 24 – page 2, line 13. Claims 1 and 8 are the independent claims. Favorable reconsideration of this application, in light of the preceding amendments and following remarks, is respectfully requested.

Applicants note with appreciation the Examiner's acknowledgement that certified copies of all priority documents have been received by the U.S.P.T.O. Action, summary at 12.

Applicants also note with appreciation the Examiner's consideration of the references cited in the Information Disclosure Statement filed on May 5, 2005.

Claim Rejections - 35 U.S.C. § 112

Claim 1 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the phrase “outer layer not blended with such an additive” (*emphasis added*) is indefinite because it is unclear whether this limitation requires the outer layer to free of any particulate additive, any type of additives or just free of particulate PTFE.

Applicants respectfully submit that claim 1 has been amended to obviate the rejection. Withdrawal of the rejection is respectfully requested.

Claim Rejections - 35 U.S.C. § 103

Claims 1-3 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,538,510 to Fontirroche et al. (“Fontirroche”) in view of U.S. Patent 6,086,970 to Ren. Applicants respectfully traverse this rejection for the reasons discussed below.

In order to establish a *prima facie* case of obviousness, the Examiner must establish that it would have been obvious for one of ordinary skill to have combined the teachings of the cited documents.¹ One way to establish this would be to show “some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness” and “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.”² Furthermore, the Examiner must make “*explicit*” this rationale of “the apparent reason to combine the known elements in the fashion claimed,” including a detailed explanation of “the effects of demands known to the design community or present in the marketplace” and “the background knowledge possessed by a person having ordinary skill in the art.”³

It is respectfully submitted that the Examiner has not met these criteria. For example, the Examiner asserts that:

[i]t would have been obvious in the art to form the inner plastic tubing layer of Fontirroche using a tubing composition similar to the one suggested by Ren since it would provide an enhanced lubricity and collapse strength to a finished tubing of Fontirroche et al.⁴

However, it is respectfully submitted that the above statement is merely conclusory and do not comprise an “*explicit rationale*” as required by *KSR Int'l*.

In addition, Applicants respectfully submit that the mere disclosure of a particulate additive composition of at least PTFE is insufficient to establish a motivation to combine. In particular, Applicants note that the relevant inquiry is not whether the Ren reference discloses an additive composition, but rather whether one of ordinary skill in the art would *desire* to combine the Ren and the Fontirroche references in order to arrive at the claimed invention. *See, e.g.,*

¹ See *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. at __, 82 USPQ2d at 1396 (2007).

² *Id.*

³ *Id.*

⁴ See Office action mailed December 20, 2007, page 3, paragraph 5b.

MPEP 2143.01(III), which states “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination,” citing *In re Mills*.⁵ That is, establishing motivation requires the Examiner to demonstrate *why one of ordinary skill in the art, absent the teachings of Applicants' application, would want to replace the inner layer region of the Fontirroche reference with the inner layer region containing additive composition of the Ren reference.* Thus, Applicants respectfully submit that the outstanding Office Action has failed to provide an objective teaching that demonstrates why one of ordinary skill in the art would be motivated to modify and/or combine the teachings of the Fontirroche and the Ren references.

Further, Applicants respectfully submit that both the Fontirroche and the Ren references explicitly *teach away* from the claimed subject matter. In particular, the claimed subject matter relates to a *filler wire guide tube for guiding a filler wire*. The filler wire is not clinically cleaned and debris may be detached from the wire material itself. Since the wire guide is supposed to feed thousands of meters of filler wire during its operation, plugging of the wire may occur. As such, the wire guide tube of the claimed subject matter is to decrease accumulation of debris and fouling so as to prevent and/or reduce sticking of the wire on the guide.⁶

In contrast, both of the Fontirroche and the Ren references teach a tube for a catheter used in the medical field, i.e., contamination or fouling is not a problem since the guide wire is pushed through the tube only limited times at short interval and in a sterile environment. That is, the guide tube in the claimed subject matter, for example, welding torch, is supposed to operate in an industrial environment and must be able to feed thousand of meters of filler wire without sticking due to fouling.

In addition, Applicants respectfully submit that the Fontirroche and the Ren references are

⁵ 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

non-analogous art. In particular, MPEP 2141.01(a) states, "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned."⁷ Although both cited references use PTFE for lowering friction, it is respectfully submitted that reducing friction is not pertinent to the particular problem as taught by Applicants' invention. For example, both cited references are used in a clean, sterile environment and does not concern itself with the wear and tear of the wire to be guided. On the other hand, the claimed subject matter relates to a wire guide for a welding torch, which operates in a completely different, opposite environment, that is concerned with contamination and fouling. Accordingly, one skilled in the art would not look to in the field of medical catheters to rely on a non-obviousness rejection, and thus, Applicants respectfully submit that no *prima facie* case of obviousness has been established.

In view of the above, Applicants respectfully submit that the Fontirroche and the Ren references fail to establish a proper *prima facie* case of obviousness, and therefore, claim 1 is allowable over the cited prior art. Claims 2, 3, and 7 are dependent from claim 1 and, therefore, also allowable. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Fontirroche and Ren as applied to claim 1 above, and further in view of U.S. Patent 5,843,031 to Hermann et al. ("Hermann"). Applicants respectfully traverse this rejection for the reasons detailed below.

Claim 4 depends from claim 1, and is therefore believed to be allowable for at least the reasons set forth above. Moreover, Applicants respectfully submit that the rejection of claim 4 is

⁶ See instant disclosure, page 1, line 24 – page 2, line 13.

⁷ See also *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

not supported by objective teachings as to *why* one of ordinary skill in the art, absent the teachings of Applicants' application, would combine the cited prior art references.

Further, in a rejection based on overlapping ranges, a *prima facie* case of obviousness may be rebutted by showing that the art, in any material respect, *teaches away* from the claimed invention. See MPEP 2144.05, citing *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). As similarly discussed above, since the Hermann reference is also related to medical catheters, it is respectfully submitted that the Hermann reference *teaches away* from the claimed subject matter, i.e., decrease accumulations of debris and fouling so as to prevent and/or reduce sticking of the wire on the guide. Accordingly, Applicants respectfully submit that the Examiner failed to set forth a *prima facie* case of obviousness with respect to claim 4.

Therefore, Applicants respectfully request that this rejection be reconsidered and withdrawn.

Claims 5 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fontirroche and Ren as applied to claim 1 above, and further in view of U.S. Patent 6,179,811 to Fugoso et al. ("Fugoso"). Applicants respectfully traverse this rejection for the reasons detailed below.

Claims 5 and 6 depend from claim 1, and are therefore believed to be allowable for at least the reasons set forth above. Moreover, Applicants respectfully submit that the rejection of claims 5 and 6 are not supported by objective teachings as to *why* one of ordinary skill in the art, absent the teachings of Applicants' application, would combine the cited prior art references.

Further, in a rejection based on overlapping ranges, a *prima facie* case of obviousness may be rebutted by showing that the art, in any material respect, *teaches away* from the claimed invention. See MPEP 2144.05, citing *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). As similarly discussed above, since the Fugoso reference is also related to medical catheters, it is respectfully submitted that the Fugoso reference *teaches away* from the

claimed subject matter, i.e., decrease accumulations of debris and fouling so as to prevent and/or reduce sticking of the wire on the guide. Accordingly, Applicants respectfully submit that the Examiner failed to set forth a *prima facie* case of obviousness with respect to claims 5 and 6. Therefore, Applicants respectfully request that this rejection be reconsidered and withdrawn.

New Claim

Applicants have added new claim 8 in connection with the present application, in an effort to further clarify the distinctions over the applied references. Claim 8 does not raise any new issues which would require further consideration and/or search as support may be found in originally filed disclosure, e.g., at page 1, line 24 – page 2, line 13. Applicants respectfully request entry and examination of claim 8.

CONCLUSION

In view of the above remarks and amendments, the Applicants respectfully submit that each of the pending objections and rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

Pursuant to 37 CFR §§ 1.17 and 1.136(a), Applicants petition for a two (2) month extension of time for filing a reply to the December 20, 2007 Office Action, and submit the required \$460.00 extension fee herewith.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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By

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